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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,860	01/28/2004	Kevin Stamp	7095MH-2	2988
22442	7590	01/11/2008		
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			EXAMINER GRAY, PHILLIP A	
			ART UNIT	PAPER NUMBER
			3767	
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			01/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,860		Applicant(s) STAMP, KEVIN	
	Examiner Phillip Gray		Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/30/2007</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS 8/24/2006</u> . |

DETAILED ACTION

This office action is in response to applicant's communication of 10/30/2007.
Currently amended claims 1-15 and 18 are pending and rejected below.

Response to Arguments

Applicant's arguments filed 10/30/2007 have been fully considered but they are not persuasive. Applicant argues that Gabriel does not disclose "wherein as a result of said plunger and barrel retracting said needle is retracted such that said at least part of said needle moved out of the outer housing in said first mode is retracted into the outer housing" in the prior art of record.

It is examiners position that Gabriel does disclose "wherein as a result of said plunger and barrel retracting said needle is retracted such that said at least part of said needle moved out of the outer housing in said first mode is retracted into the outer housing". Examiner draws attention to figures 14 and 15 which evidence a transition from first mode through third mode and show a part of the needle that was moved out of the outer housing is retracted into the outer housing in the third mode. Further concerning the amendment to claim 18, it is examiners position that that a first and second portion of the inner housing are separated by a "first distance" and they are separated by a first distance while the pluger is moved axially. Compare figures 4 and 5 in operation and "first distance" of the inner housing portions.

During examination, claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969).

In response to applicant's argument that the applicant's device has a different needle/barrel retraction usage and inner housing first and second portion "first distance" operation, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant is reminded that, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The elements disclosed in Gabriel prior art is fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made and proper. See rejection discussion below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gabriel (U.S. Patent Number 6,544,234). Gabriel discloses an automatic self-injection device. Gabriel discloses an apparatus and method comprising an outer housing (46, 126 for example) and inner housing (100, 96, 92 for example), a barrel (12), needle (18), plunger (28,22), energy source (94) and actions of a first mode (figures 4) in which the inner housing acts on the barrel such that, in use, the plunger and barrel are movable axially so as to move at least part of said needle out of the outer housing; a second mode (figure 5) in which the inner housing acts on the plunger but not the barrel such that, in use, said plunger is movable axially into said barrel so as to expel medicament through the needle; and a third mode (figure 15) in which the inner housing acts on neither the plunger nor the barrel such that, in use, the plunger and barrel are able to retract in order to retract the needle into the outer housing (further see paragraphs at columns 1-5) .

Gabriel discloses an inner housing that includes one or more flexible "L" or "T" shaped tags (100), situated at the rear end of the inner housing (disclosed see above) and biased radially inwardly by communication with said outer housing and plunger and is moveable out of communication with the plunger when aligned with a corresponding recess in the outer housing (figures 6-9).

Gabriel discloses one or more "L" or "T" shaped tags (100) that are situated at the forward end of the inner housing and are biased radially into communication with the barrel and are moveable out of communication with the barrel when aligned with a corresponding recess in the outer housing (see figures 3-8).

Gabriel is fully capable of having a means for allowing the inner housing to move axially only forward with respect to the outer housing by means (112).

Gabriel discloses a needle is biased to be normally wholly inside said housing by means of a spring intermediate (56) the barrel and the outer housing (figure 15) and the needle, barrel and plunger are removable from said device with a removable protective sheathed needle cover (120) which protects the needle during storage before use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gabriel. Gabriel discloses the claimed invention except for the energy source being a compressed gas. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an energy source of compressed gas since it was known in the art that pneumatic driven compressed gas is an alternative means to a spring driven syringe. It would have been obvious to one having ordinary skill in the art at the time the invention was made since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192 (CCPA 1958).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

Kevin C. Sirmons